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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,775	04/10/2006	Dieter Jorgens	P05,0424	7977
26574	7590	10/01/2008		
SCHIEF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			EXAMINER GERGISO, TECHANE	
			ART UNIT 2137	PAPER NUMBER
			MAIL DATE 10/01/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/562,775

**Applicant(s)**

JORGENSEN ET AL.

**Examiner**

TECHANE J. GERGISO

**Art Unit**

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-108)  
Paper No(s)/Mail Date 12/29/2005; 04/10/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is a non-Final Office Action in response to the applicant's communication filed on October 24, 2007.
2. Claims 24-50 have been examined and are pending.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Revel et al. (hereinafter referred to as, Revel, US Pub No.: 2003/0063749 A1) in view of Snyders (US Pub. No.: 2004/0080772 A1).

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As per claim 24:

Revel discloses a method for printing of sensitive data, comprising the steps of:  
at a workstation encrypting sensitive data to be printed (0015);  
transferring to a printing device having a printing unit the encrypted sensitive data to be  
printed (0016; 0015; 0017);  
decrypting the sensitive data to be printed to create decrypted sensitive data (0014; 0017;  
0019; 0020);

not storing the decrypted sensitive data in a readable decrypted form after the decrypting but before printing of the data, but rather storing the decrypted sensitive data in a non-volatile memory such that the decrypted sensitive data are distributed in a plurality of memory segments of the non - volatile memory where a relationship of the memory segments in the non-volatile memory is stored as relationship data independently of the stored decrypted sensitive data (0015; 0021; 0025); and printing the decrypted sensitive data with the printing unit on a recording medium (0014; 0017; 0019; 0020);.

Revel does not explicitly teach converting the decrypted sensitive data to be printed into control signals for activation of the printing unit. Snyders, in an analogous art, however teaches converting the decrypted sensitive data to be printed into control signals for activation of the printing unit (0008; 0045; 0046). Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the system disclosed by Revel to include converting the decrypted sensitive data to be printed into control signals for activation of the printing unit. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do to provide a system and method for securing and tracking a document transmitted over an open network and a printing facility connected to the customer along a workflow path as suggested by Snyders (0008).

As per claim 25:

Snyders discloses a method, wherein said decrypted sensitive data is stored in said non-volatile memory as said control signals representing said decrypted sensitive data (0008; 0045; 0046).

As per claim 26:

Snyders discloses a method, wherein the step of relating the memory segments using said relationship data and then printing the decrypted sensitive data (0008; 0045; 0046).

As per claim 27:

Snyders discloses a method, wherein the relationship data is stored in a volatile memory (0045).

As per claim 28:

Snyders discloses a method, wherein the control signals containing decrypted sensitive data are stored in a volatile memory (0008; 0045; 0046).

As per claim 29:

Snyders discloses a method, wherein the decryption and the conversion into control signals are executed in immediate temporal succession (0039).

As per claim 30:

Snyders discloses a method, wherein the decryption and the conversion into control signals is executed in a controller for activation of a character generator (0045-0046).

As per claim 31:

Snyders discloses a method, wherein print data are provided comprising both said sensitive data and non-sensitive data (0083).

As per claim 32:

Snyders discloses a method, the print data to be printed are transferred to the printing device in the form of a print data stream, the print data stream being converted into an intermediate language in the printing device, and the print data being converted into control signals (0004; 0005; 0016).

As per claim 33:

Snyders discloses a method, wherein the sensitive data and the non-sensitive data are connected into one data unit before transfer to the printing device (0083).

As per claim 34:

Revel discloses a method, wherein the sensitive data are identified in the data unit via markings (0013; 0016).

As per claim 35:

Snyders discloses a method, wherein a layout that comprises regions to receive sensitive data is generated using the non-sensitive data (0083).

As per claim 36:

Revel discloses a method, wherein the sensitive data are already encrypted before combination with the non-sensitive data into said one data unit (0016).

As per claim 37:

Snyders discloses a method, wherein the sensitive data are encrypted after combination with the non-sensitive data into said one data unit (0051; 0057; 0058).

As per claim 38:

Snyders discloses a method, wherein only the sensitive data are encrypted (0051; 0057; 0058).

As per claim 39:

Snyders discloses a method, wherein both the sensitive data and the non-sensitive data are encrypted (0051; 0057; 0058).

As per claim 40:

Revel discloses a method, wherein the conversion of the sensitive data to be printed into control signals for activation of the printing unit via rastering of the data to be printed into one or

more raster images is executed, whereby the raster images represent the control signals (0016; 0019; 0020).

As per claim 41:

Revel discloses a system for printing sensitive data which have been encrypted, comprising:

a printing device having a printing unit connected to a controller, said controller receiving said encrypted sensitive data (0016; 0015; 0017);

said controller comprising a decryption module, a non-volatile memory, a relationship data memory (0014; 0017; 0019; 0020); and

in said controller not storing the decrypted sensitive data in a readable decrypted form after the decrypting, but before printing of the data, but rather storing the decrypted sensitive data in said non-volatile memory such that the decrypted sensitive data are distributed in a plurality of memory segments of the non-volatile memory, and wherein a relationship of the memory segments in the non-volatile memory is stored as relationship data in said relationship data memory independently of the stored decrypted sensitive data (0015; 0021; 0025).

Revel does not explicitly teach a converter which converts decrypted sensitive data from said decryption module into control signals for activation of said printing unit. Snyders, in an analogous art, however teaches a converter which converts decrypted sensitive data from said decryption module into control signals for activation of said printing unit (0008; 0045; 0046).



Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the system disclosed by Revel to include a converter which converts decrypted sensitive data from said decryption module into control signals for activation of said printing unit. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do to provide a system and method for securing and tracking a document transmitted over an open network and a printing facility connected to the customer along a workflow path as suggested by Snyders (0008).

As per claim 42:

Snyders discloses a system, wherein said decrypted sensitive data is stored in said non-volatile memory as said control signals representing said decrypted sensitive data (0008; 0045; 0046).

As per claim 43:

Snyders discloses a system, wherein the controller relates the memory segments using said relationship data for printing the decrypted sensitive data (0008; 0045; 0046).

As per claim 44:

Snyders discloses a system, wherein said relationship data memory comprises a volatile memory (0045).

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As per claim 45:

Snyders discloses a system, wherein the printing unit comprises a character generator (0045-0046).

As per claim 46:

Snyders discloses a system, wherein the controller comprises at least one raster module as said converter (0016; 0019; 0020).

As per claim 47:

Snyders discloses a system, wherein the controller comprises a combined decryption/raster module (0008; 0045; 0046).

As per claim 48:

Snyders discloses a system, wherein the controller comprises volatile storage media (0045).

As per claim 49:

Revel discloses a system, wherein a sensor for detection of recording media with predetermined security features is arranged on a transport path for recording media in a region before the printing unit such that the printing of sensitive data can be stopped given detection of recording media without security features (0016; 0019; 0020).

As per claim 50:

Revel discloses a method for printing of sensitive data, comprising the steps of:

transferring to a printing device having a printing unit encrypted sensitive data to be printed (0016; 0015; 0017);

decrypting the sensitive data to be printed to create decrypted sensitive data (0014; 0017; 0019; 0020);

storing the decrypted sensitive data in a non-volatile memory such that the decrypted sensitive data are distributed in a plurality of memory segments of the non-volatile memory where a relationship of the memory segments in the non-volatile memory is stored as relationship data independently of the stored decrypted sensitive data (0015; 0021; 0025); and

printing the decrypted sensitive data with the printing unit on a recording medium (0014; 0017; 0019; 0020).

Revel does not explicitly teach converting the decrypted sensitive data to be printed into control signals for activation of the printing unit. Snyders, in an analogous art, however teaches converting the decrypted sensitive data to be printed into control signals for activation of the printing unit (0008; 0045; 0046). Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the system disclosed by Revel to include converting the decrypted sensitive data to be printed into control signals for activation of the printing unit. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do to provide a system and

method for securing and tracking a document transmitted over an open network and a printing facility connected to the customer along a workflow path as suggested by Snyders (0008).

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the notice of reference cited in form PTO-892 for additional prior art.

### **Contact Information**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Techane J. Gergiso whose telephone number is (571) 272-3784 and fax number is ~~(571) 273-3784~~. The examiner can normally be reached on 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Techane J. Gergiso/

Examiner, Art Unit 2137

/Emmanuel L. Moise/

Supervisory Patent Examiner, Art Unit 2137